

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP AF
Daisuke Sakiyama et al.)	Group Art Unit: 2181
Application No.: 10/775,080)	Examiner: Chun Kuan Lee
Filed: February 11, 2004)	Confirmation No.: 3417
For: DATA OUTPUT APPARATUS)	

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Reconsideration and allowance of this application are respectfully requested.

Claims 1-17 remain pending.

In numbered paragraph 7 on page 6 of the Office Action, the PTO maintained the previous rejection in which claims 1-17 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Utsunomiya* (U.S. Patent No. 6,999,186) in view of *Kizaki* (U.S. Patent Publication No. 2003/0035142) and further in view of *Terajima* (U.S. Patent No. 5,309,251). Applicants respectfully traverse this rejection.

As stated in the previous response, the combination of *Utsunomiya*, *Terajima*, and *Kisaki* still do not establish a *prima facie* case of obviousness.

Terajima cannot reasonably be combined with *Utsunomiya* to achieve the claimed results because integrating the primary reference *Utsunomiya*, with the teachings of the secondary reference *Terajima*, as proposed by the Examiner, would destroy the operability of the former.

Utsunomiya discloses a system in which image data for each input image is first stored in an input/output buffer 1032. The data stored in buffer 1032 is

rasterized and then stored in a rasterized image storage area 3008. Both the buffer 1032 and image storage area 3008 are contained within the same device RAM 1037. See Utsunomiya, Figure 3 and col. 5, line 58 through col. 6, line 32. *Utsunomiya* further discloses an external memory 1043 is used when the buffer 1032 and/or storage area 3008 are full. See Id., col. 6, lines 33-44. Moreover, the external memory 1043 is used to store print data and various kinds of information of the printing apparatus including font data, form data, and data and control codes received from the host, among other information. See Id., col. 5, lines 5-14. The external memory also often stores a program that is loaded onto the RAM 1037 and is executed by a CPU 1035. See Id., col. 5, lines 15-16.

Terajima discloses a facsimile apparatus that enables an external memory 109 to be detachably loaded. When a sensor 119 detects that the external memory is loaded, a communication result is stored in the external memory. Alternatively, when the sensor does not detect the external memory, the communication result is stored in a RAM 115 of the main body.

On page 3 of the Office Action, the PTO alleges that the combination of *Utsunomiya* and *Terajima* discloses Applicants' claimed detection unit that detects whether or not the expansion memory is mounted to a mounting unit, and a controller that stores image data based on the detection. However, because the external memory of *Utsunomiya* stores various kinds of information of the printing apparatus, there appears to be no scenario in which the disclosed device can be configured without having the external memory 1043. For example, *Utsunomiya* discloses that during either of a first or second method for printing plural copies, most of the print data is stored on the hard disk (3011, 3012). Thus, when printing

multiple copies the system of *Utsunomiya* is seemingly configured such that most of the data to be printed is stored on the hard disk. This infers that if the hard disk was not provided the printing of multiple copies would not be possible due to insufficient memory. In other words, based on the guidance provided by *Utsunomiya*, the external memory 1043 is necessary for successfully executing a printing operation or generating a print output. For this reason, Applicants believe no rational basis exists that would lead one of ordinary skill to combine the teachings *Utsunomiya* and *Terajima* as hypothesized in the Office Action to achieve the claimed results.

Even assuming *arguendo* that it is reasonably foreseeable that one of ordinary would have combined the teachings of these two references, Applicants respectfully submit that the proposed modification of *Utsunomiya* would change the principal operation of the disclosed device and likely render the modified device unsatisfactory for its intended purpose. As discussed above, the external memory 1043 appears necessary for the device of *Utsunomiya* to successfully execute a printing operation or generate a print output. Stated differently, *Utsunomiya* arguably cannot satisfactorily produce an output if the external memory 1043 is not attached.

Kizaki is applied for its alleged disclosure of a technique in which a first copy of image data is printed from data stored in a primary memory device and a second and subsequent copies being printed using data stored in a secondary memory device. While Applicants do not acquiesce to this alleged interpretation, Applicants respectfully submit that *Kizaki* does not remedy the alleged deficiencies of *Utsunomiya* and *Terajima* with respect to Applicants' claimed detection unit and controller.

In summary, *Utsunomiya*, *Kizaki*, and *Terajima* when applied individually or collectively fail to establish a *prima facie* case of obviousness, because not all features of Applicants' claims are disclosed. Applicants' remind the PTO that the Office has the initial burden of establishing a **factual basis** to support the legal conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added). Based on the foregoing discussion, withdrawal of this rejection is respectfully requested.